

**REMARKS**

Upon entry of this Request for Reconsideration, claims 36-38, 40, 43-45, 47-58, 64-68, and 81 will remain pending.

**Response to Rejections Under 35 U.S.C. § 103:**

In the Office Action dated May 12, 2009, claims 4, 5, 7, 8, 12-15, 36-39, 41, 42, and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Brown* (U.S. Patent No. 5,350,109) in view of *Wilson* (U.S. Patent No. 5,072,876), either *Reeser* (U.S. Patent No. 2,568,204) or *Negelen* (U.S. Patent No. 6,250,542), and either *Sutherland* (U.S. Patent No. 6,112, 977) or *Skolik* (U.S. Patent No. 6,170,741), claims 36-39, 41, and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Brown* in view of *Wilson*, either *Reeser* or *Negelen*, and *JP '243* (Japan 47-7243), claims 9, 16, and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the prior art as applied to claims 8, 15, and 42, respectively, and further in view of *Sherman* (U.S. Patent No. 3,166,229), claims 10, 11, 17-20, and 44-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the prior art as applied to claims 9, 16, and 43, and further in view of *Gilchrist* (U.S. Patent No. 3,533,549). Applicant traverses these rejections.

The Final Rejections under 35 U.S.C. § 103(a) should be withdrawn in the present application for at least the following three reasons:

1. A prima facie case of obviousness has not been established.
2. *Brown* cannot be modified as proposed.
3. No motivation exists to combine the art as proposed.

**1. A Prima Facie Case of Obviousness has not been established:**

Although the Examiner provided three reasons in support of the proposed combination of references, the Final Office Action fails to address that *Brown* cannot be modified as proposed (Applicant argued such in the January 20, 2009 Amendment). In lieu of a conventional combination rejection with a base reference modified with teachings from a secondary reference, it appears that the Examiner is alleging that the art as a whole suggests the desirability of the proposed combination. Specifically, reason 2 at pages 5 and 6 of the Final Office Action states:

The prior art to Wilson (as well as several other secondary references) suggests that formation of handle openings without folded flaps is knowledge that is clearly present within the art. It is believed that elimination of the part and its function, if not needed, is within the level of skill in this art. One of ordinary skill in this art would not have been led away from the combination as a result of whether the handle flaps of Brown et al were to be used or not. The box of Brown et al is useful to package contents and to be carried using the handle flaps regardless of whether the additional advantage of the handle flaps is present or not. Obviousness is a determination of whether the claimed invention would have been obvious to one of ordinary skill in this art having knowledge of all the prior art as opposed to the inventors in the Brown et al reference.

However, the standard presented in the Final Office Action oversimplifies obviousness, which is presented in MPEP 2143 as:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the present application, the final rejections fail at least the first two criteria of obviousness: (1) the cited art and the general knowledge in the art fails to provide a suggestion or motivation to

modify the base reference (*Brown*) and (2) *Brown* cannot be modified as proposed without rendering the carton of *Brown* unsatisfactory for its intended purpose, thus, no reasonable expectation of success of modifying *Brown* as proposed exists.

New references, *Reeser* and *Negelen*, have been added in the Final Office Action, but such references fail to address the inadequacies of the previously cited references, namely how *Brown* can be modified to reach the claimed invention without destroying the functionality of *Brown*. The addition of a reference purportedly showing three layers of paperboard adjacent the handle does not relieve the Examiner of his burden of providing why a person of ordinary skill in the art would be motivated to apply the teachings of the secondary reference to modify the base reference to reach the claimed invention. The Final Office Action fails to provide such motivation. As presented in the January 20, 2009 Amendment, *Brown* cannot be modified by adding an insert without a teaching that the insert would collapse in a concertina manner to mimic the panels above the handle as intended by *Brown*. Even if the additional references were found to provide a three-ply handle as alleged by the Examiner, a prima facie case of obviousness is still lacking since the references and underlying rejections lack both a reason for adding an insert to *Brown* and a teaching of how the insert would collapse as intended by *Brown*. Absent such reasons, the rejections based on *Brown* should be withdrawn.

**2. *Brown* Cannot Be Modified As Proposed:**

The Abstract of *Brown* details a two layer paperboard carton with “an incipient handhold that is adapted to partially break away from surrounding portions of a carton wall, and to sequentially collapse in a predetermined reverse folding or “concertina” fashion, to provide a folded load-bearing handhold structure.” To achieve such folding, *Brown* provides exterior and

interior flaps that are “arranged in mutually co-operable register with the respective interior layer and exterior layer score lines positioned parallel and adjacent to one another in cooperative lower hinge-forming relation.” However, *Brown* fails to provide a reinforcing insert whatsoever, and specifically an insert with score lines arranged to cooperate with corresponding score lines in the interior and exterior layers that would allow the handholds to collapse as intended by *Brown*. In fact, it appears that providing an insert panel would interfere with the function/operation of the buckling intended in *Brown*. The Examiner continues to base his rejections on *Brown*, and has added an additional reference (*Reeser* or *Negelen*) and asserts that the additional reference “teaches the desirability of making handle apertures in the sides of a container using three plies” (page 2 of the Final Office Action). However, none of the inserts or flaps of *Reeser*, *Negelen*, *Wilson*, *Sutherland*, *Skolik*, *JP ‘243*, *Sherman*, or *Gilchrist* provide score lines therein, especially insert score lines aligned with inner and outer carton layer score lines as would be required to provide such an insert in the carton of *Brown* (*Wilson* appears to be improperly referenced as providing “foldlines in the insert using perforations,” since *Wilson* does not appear to support this reference by the Examiner). Absent a teaching or suggestion to provide score lines in the insert, modifying *Brown* by adding an insert as proposed by the Examiner would not allow the handles of *Brown* to concertina as intended, and would, in fact, interfere with the operation of the *Brown* concertina action. Further, even if score lines were provided by a reference, a teaching or suggestion to align or register such insert score lines is not provided in *Brown* or the other cited references. Thus, since modifying *Brown* as proposed by the Examiner would render *Brown* unsatisfactory for its intended purpose (providing a breakaway handhold), the combinations could not, and would not, be made as proposed. (See MPEP 2143.01(v)).

3. **No motivation exists to combine the art as proposed.**

A person of ordinary skill in the art viewing *Brown*, or even viewing all the cited art as a whole as appears to be the basis of the obviousness rejections by the Examiner, would not be motivated to modify *Brown* to reach the claimed invention without using the present disclosure as motivation, which would be impermissible hindsight. The cited references entirely fail to provide a teaching or suggestion to provide a carton or blank as claimed, i.e. with three layers of paperboard between the first top fold line and the first handle aperture and an insert in alignment with the handle aperture. *Brown*, *Wilson*, *Reeser*, *Negelen*, *Sutherland*, *Skolik*, *JP '243*, *Sherman*, and *Gilchrist* provide teachings to form cartons with specific features. None of these references suggesting modification of the specific carton features or motivation to combine such disparate teachings to reach the claimed invention. The Examiner's only statements in this regard are at pages 2-3 of the Final Office Action:

It would have been obvious to provide reinforcement to the end wall handle apertures in *Brown et al* with an insert or inserts as taught by *Wilson* and to form the insert or inserts as a separate blank as taught by either *Sutherland et al* or *Skolik et al* as a matter of combining the elements according to known methods to yield the predictable results. See *KSR Int'l Col. V. Teleflex Inc.*, 127 S.Ct. 1727, 1742; 82 USPQ2d 1385, 1396 (2007). It would further have been obvious to maintain the partial handle apertures in the end panel flaps 25 and 27 in modified *Brown et al* in view of the teaching in either *Negelen* or *Reeser* as a way of forming a three ply handle structure to reinforce the handle.

However, there is no "known method" for forming a three-ply handle in the *Brown* structure. Since *Brown* cannot be modified as proposed without destroying the functionality intended, the Examiner's reasoning that the elements would be combined "according to known methods to yield the predictable results" lacks support in *Brown* as such modification is not predictable, as discussed above, and does not yield predictable results. Thus, the Examiner continues to fail to

make a prima facie case of obviousness and rejections based upon such proposed combinations should be withdrawn.

The dependent claims are allowable on their own merit as including elements not shown or disclosed in the prior art, and are allowable as inheriting the allowable characteristics of the independent claims from which they depend.

### CONCLUSION

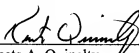
Applicant respectfully asserts that all claims are in condition for allowance and requests that a Notice of Allowance be issued. If issues may be resolved through Examiner's Amendment, a call to the undersigned attorney is courteously solicited.

The Commissioner is authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 09-0528.

Respectfully submitted,

Date: 10/12/09

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